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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,242	02/01/2002	Andrew Richard Wainwright	294-107 PCT/US	9497

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EXAMINER

BECKER, DREW E

ART UNIT	PAPER NUMBER
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1794

MAIL DATE	DELIVERY MODE
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08/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/936,242	Applicant(s) WAINWRIGHT ET AL.	
	Examiner Drew E. Becker	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5-7, 9-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanner et al [Pat. No. 6,022,574] in view of Tallberg et al [Pat. No. 5,824,798] and Buwalda [Sheer Versatility].

Lanner et al teaches a snack food comprising potato flour in the form of flakes and/or granules(column 3, line 8), the flour constituting 35-60% of the product (column 2, line 4), other cereal flours (column 3, line 4), additives such as emulsifiers (column 3, line 47), the snack products being fried and extruded (column 2, lines 2 & 25), 2-20% pregelatinized waxy starches (column 4, lines 47-54) wherein waxy starch was commonly accepted to consist of substantially 100% amylopectin starch, and oil (column 4, line 55). Lanner et al do not recite using a potato with an amylopectin content of at least 95%, at least 20% of the food being flakes and/or granules made from the high amylopectin potato, greater expansion, and the potato being genetically modified. Tallberg et al teach a genetically modified potato with an amylopectin content of 100% (claim 1; column 1, lines 37-44). Buwalda teach a potato with 100% amylopectin starch (Table 1) and improved expansion properties in snack foods (page 13, column 3, paragraph 1). It would have been obvious to one of ordinary skill in the art

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to incorporate the high amylopectin potatoes of Tallberg et al and Buwalda into the invention of Lanner et al since all are directed to food products, since Lanner et al did not specify the particular types of potatoes to be used, since Lanner et al already used 2-20% waxy starches (column 4, line 54) which were commonly known to possess a high amylopectin content of substantially 100%, since Lanner et al teach chemically modifying the starch to alter the properties of the dough (column 3, line 18), since a small number of the 100% amylopectin potatoes of Tallberg et al would have easily provided the necessary amylopectin content required by Lanner et al, since the 100% amylopectin potato starch of Tallberg et al has not been subjected to chemical modification thus making it more suitable as a food ingredient (column 1, lines 37-44), and since the 100% amylopectin potato starch provided improved expansion properties in snack foods, as taught by Buwalda (page 13, column 3, paragraph 1).

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lanner et al, in view of Tallberg et al and Buwalda, as applied above, and further in view of Fazzolare et al [Pat. No. 4,834,996].

Lanner et al, Tallberg et al, and Buwalda teach the above mentioned components.

Lanner et al, Tallberg et al, and Buwalda do not recite baking. Fazzolare et al teach a method for making baked, extruded potato-based snack foods (abstract). It would have been obvious to one of ordinary skill in the art to incorporate the baking of Fazzolare et al into the invention of Lanner et al, in view of Tallberg et al and Buwalda, since all are directed to potato-based food products, since Lanner et al already included cooking via

frying, since Fazzolare et al taught that snack foods were commonly cooked via baking, and since many consumers preferred baked snack foods due to their lower fat content.

4. Claims 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lanner et al, in view of Tallberg et al and Buwalda, as applied above, and further in view of Martines-Serna Villagram et al [Pat. No. 6,544,580].

Lanner et al, Tallberg et al, and Buwalda teach the above mentioned components.

Lanner et al, Tallberg et al, and Buwalda do not recite using a Saturna variety potato, or less than 5% reducing sugars. Martines-Serna Villagram et al teach a snack food comprising potato flakes (column 10, lines 15-28), using Saturna variety potatoes (column 4, line 28), and using less than 5% reducing sugars (column 11, lines 50-64). It would have been obvious to one of ordinary skill in the art to incorporate the Saturna potatoes and less than 5% reducing sugars of Martines-Serna Villagram et al into the invention of Lanner et al, in view of Tallberg et al and Buwalda, since all are directed to potato-based food products, since Lanner et al simply did not specify the potato varieties used and amount of reducing sugars, and since Martines-Serna Villagram et al teaches that Saturna potatoes and less than 5% reducing sugars were common materials and traits for extruded potato products.

Response to Arguments

5. Applicant's arguments filed 5/27/08 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that Buwalda only mentions isolated starch, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Regardless, Buwalda teaches good expansion properties when incorporated into snacks (page 13). It would have been obvious to one of ordinary skill in the art to incorporate the high amylopectin potatoes of Tallberg et al and Buwalda into the invention of Lanner et al since all are directed to food products, since Lanner et al did not specify the particular types of potatoes to be used, since Lanner et al already used 2-20% waxy starches (column 4, line 54) which were commonly known to possess a high amylopectin content of substantially 100%, since Lanner et al teach chemically modifying the starch to alter the properties of the dough (column 3, line 18), since a small number of the 100% amylopectin potatoes of Tallberg et al would have easily provided the necessary amylopectin content required by Lanner et al, since the 100% amylopectin potato starch of Tallberg et al has not been subjected to chemical

modification, making it more suitable as a food ingredient (column 1, lines 37-44), and since the 100% amylopectin potato starch provided improved expansion properties in snack foods, as taught by Buwalda (page 13, column 3, paragraph 1).

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Drew E. Becker whose telephone number is 571-272-1396. The examiner can normally be reached on Mon.-Fri. 8am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Drew E Becker/
Primary Examiner, Art Unit 1794